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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Digene Diagnostics, Inc.
v.
National Diagnostics

Opposition No. 95,464
to application Serial No. 74/435,728
filed on September 15, 1993

Christopher P. Bussert and Michael K. Heilbronner of
Kilpatrick & Cody for Digene Diagnostics, Inc.

Benita J. Rohm of Miller, Canfield, Paddock & Stone for
National Diagnostics.

Before Quinn, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by National Diagnostics
to register the mark shown below

DIOGENES

for "chemicals for detecting and enhancing chemiluminescence and bioluminescence for use in the biotechnology industry."¹

Registration has been opposed by Digene Diagnostics, Inc. on the ground that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used trade name and trademark DIGENE for diagnostic and research reagents, and DNA-probe based diagnostic test kits for the determination and monitoring of human diseases, as to be likely to cause confusion.

Applicant, in its answer, denied the salient allegations of likelihood of confusion. Applicant also set forth, captioned as "affirmative defenses", allegations which amplified its denials.²

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by opposer; the non-confidential portion, with related exhibits, of a discovery deposition introduced by opposer by way of a notice of reliance; and excerpts from printed publications, and opposer's response to one of applicant's requests for admissions, made of record in

¹Application Serial No. 74/435,728, filed September 15, 1993, alleging dates of first use of April 6, 1992.

²Applicant's answer is accompanied by exhibits. Exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits. Trademark Rule 2.122(c); and Trademark Trial and Appeal Board Manual of Procedure, § 313.

applicant's notice of reliance.³ Both parties filed briefs on the case.

Opposer sells chemicals, including diagnostic and research reagents, DNA-probe based diagnostic test kits for the determination and monitoring of human diseases, and chemicals for detecting and enhancing chemiluminescence for use in the biotechnology industry. Annual sales of such goods under the trade name and trademark DIGENE have ranged from \$420,000 to over \$5 million. Annual advertising expenditures in recent years have exceeded \$3 million.

Applicant also sells chemicals, including kits (containing a reagent and an activator) used to detect and enhance chemiluminescence and bioluminescence for use in the biotechnical industry. Dr. Jeffrey Mirsky, applicant's president, characterized applicant's yearly sales under the mark DIOGENES as "negligible, in the order of a few thousand dollars."

There is no dispute with respect to the issue of priority of use.⁴ Moreover, the record establishes that

³The listings of the testimony depositions and related exhibits in both of the notices of reliance are superfluous inasmuch as this evidence is part of the record pursuant to Trademark Rule 2.125.

⁴Applicant, in its brief, states the following: "Applicant concedes that Opposer used the word 'Digene,' a corporate name, prior to Applicant's use of the mark DIOGENES. However, Applicant does not concede that the word 'Digene' is, or was, used by Opposer in a trademark sense as will be discussed in greater detail hereinbelow." (brief, p. 2, n. 1) (emphasis in original) Applicant then goes on to argue essentially that opposer has exclusively used DIGENE as a trade name, and not as a trademark, and that, as a result thereof, DIGENE lacks distinctiveness as a source indicator.

opposer's use predates the earliest date upon which applicant may rely for priority.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding now before us are discussed below.

We first turn our attention to the relatedness of the parties' goods. In considering the goods, we start with the premise that they need not be identical or even competitive to support a holding of likelihood of confusion. It is sufficient that the goods are so related or that conditions surrounding their marketing are such that they are encountered by the same persons who, because of the relatedness of the goods and the similarities between the marks, would believe mistakenly that the goods originate from or are in some way associated with the same producer. Hercules Inc. v. National Starch and Chemical Corp., 223 USPQ 1244, 1247 (TTAB 1984).

This argument is made for the first time in applicant's brief at final hearing. The answer was never amended accordingly, and applicant is belated in its attempt to raise the issue at the last possible moment in this case. Nonetheless, applicant's argument is easily dismissed. As pointed out by opposer, it may prevail on prior use of either a trademark or a trade name. West Florida Seafood Inc. v. Jet Restaurants Inc., 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994). Suffice it to say that we fully agree with opposer's rebuttal arguments on this issue, the sum of which is that the record clearly establishes both prior trademark and trade name use by opposer of the term DIGENE.

The question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Applicant seeks to register its mark for goods identified as "chemicals for detecting and enhancing chemiluminescence and bioluminescence for use in the biotechnology industry."

These are chemicals that, when applied to a specimen, produce light. From an analysis of the light produced by a treated specimen, researchers can ascertain traits about the specimen. Inasmuch as applicant's identification of goods does not include any limitations as to applications of use, it must be assumed that the goods may be used in all normal applications in the biotechnology industry.

Clayton Collier, opposer's technical support scientist, and Deborah Oronzio, opposer's director of marketing, testified about the nature of opposer's goods sold under the mark and trade name DIGENE. Opposer itself has sold chemicals for detecting and enhancing chemiluminescence as a component of a complete system. Although this system of products is branded "Hybrid Capture System", the system also bears the mark DIGENE. (see, e.g., exhibit 8 showing "Digene Hybrid Capture System" for "a chemiluminescent

molecular hybridization assay for the analysis of human papillomavirus (HPV) DNA groups in cervical specimens.") Opposer also sells a variety of biomedical research products under its mark. The testimony further shows that both parties' goods are sold to university research labs, government research labs and commercial research labs, including those that conduct biotechnology research.

Applicant contends that the relevant purchasers of the parties' goods are sophisticated. More specifically, applicant asserts that purchasers of the goods are well-educated clinical or medical professionals, scientists and researchers, all of whom exercise great care and attention in ordering a product to perform a medical test or a biological assay.

The highly technical nature of the parties' products appears to dictate purchases by sophisticated individuals. Although the actual order may be placed by a nonprofessional (according to opposer), the individuals who actually request that the order be placed (i.e., the end users of the goods) are undoubtedly highly trained professionals. In any event, as often stated, even sophisticated purchasers are not immune from confusion as to source. See, e.g., *In re Inspection Technology Inc.*, 223 USPQ 46, 48 (TTAB 1984).

In short, the goods are sufficiently related and move in similar channels of trade to similar classes of purchasers such that, if sold under similar marks, confusion would be likely to occur.

With respect to the marks, we find that opposer's mark DIGENE is similar to applicant's mark DIOGENES in visual appearance. In terms of sound and meaning, applicant contends that the marks are readily distinguishable. Applicant argues that its mark is correctly pronounced as "di-oj-c-nez" whereas opposer's mark is pronounced "di-jen." In this connection, applicant asserts that its mark is the name of the Greek philosopher Diogenes. Applicant claims that Diogenes is "well known to persons having only an elementary level of formal education" and that "even ordinary consumers would not mispronounce, misspell, or otherwise be unfamiliar with, the word 'DIOGENES' or its ordinary meaning." In this connection, applicant introduced several excerpts from printed publications and dictionaries showing that Diogenes is the name of a Greek philosopher who carried a lantern through the streets of Athens in the daytime in search of an honest man. The name has appeared in textbooks, a cartoon, a children's book, a novel, an encyclopedia and dictionaries.⁵

As for the similarity of the marks in terms of sound, DIGENE and DIOGENES are different if pronounced by someone familiar with the Greek philosopher. However, for those not familiar, the marks, when pronounced, can be similarly

⁵Applicant has requested the Board to take judicial notice that the word "Diogenes" is in the spell check tool of at least two word processing programs. The Board denies applicant's request, the view being that this is not the kind of fact which may be judicially noticed. We hasten to add, however, that even if this fact were of record, the ultimate result in this case would be the same.

sounding. Moreover, it must be remembered that "there is no correct pronunciation of a trademark." In re Belgrade Shoe Co., 411 F.2d 1352, 162 USPQ 227 (CCPA 1969). Imperfectly pronounced, the two marks can be very similar in terms of sound.

Turning to a consideration of the connotations of the marks, applicant urges that the marks are different in that opposer's mark DIGENE is a coined term, whereas applicant's mark DIOGENES refers to the Greek philosopher. Applicant has failed, however, to present evidence that the familiar term is readily distinguishable from the unfamiliar term. That is to say, applicant has presented insufficient evidence showing that "Diogenes" would be known beyond a relatively small segment of the American public. As noted above, applicant has made of record excerpts from various publications showing that Diogenes is a Greek philosopher, and that his name has appeared in a variety of works. However, this evidence, by itself, does not show that the term is known to more than a small portion of the American population. Obviously, many words listed in dictionaries, encyclopedias, textbooks and other works are not known to the American public. As the Board observed in E. I. du Pont de Nemours and Co. v. Sunlyra International Inc., 35 USPQ2d 1787, 1789 (TTAB 1995):

If all words and terms found in dictionaries and other reference works were generally known to the American public, the need for such dictionaries

and reference works would be exceedingly small. The predecessor to our principal reviewing court has observed that the mere appearance of a term in a dictionary or other reference work does not establish that the term is known to an appreciable number of Americans. For example, in *National Distillers Corp. v. William Grant & Sons, Inc.*, 505 F.2d 719, 184 USPQ 34 (CCPA 1974), the court observed that while the word "duvet...is to be found in Webster's Third New International Dictionary...we think practically no Americans other than experts in fungus cultures would be aware of this...[unfamiliar] English word. 184 USPQ at 35. See also *Lever Bros. Co. v. Babson Bros. Co.*, 197 F.2d 531, 194 USPQ 161, 164 (CCPA 1952).

Mr. Mirsky also testified on behalf of applicant in regards to the meaning of "Diogenes." Mr. Mirsky explained applicant's choice of the mark as follows: "Diogenes is the Greek character who searched with a lantern looking for an honest man, and this being well known in the literature seemed to represent our product which lit up when it encountered or encountering the appropriate ion that we were trying to detect." Again, Mr. Mirsky never testified as to the general awareness of the Greek philosopher Diogenes among Americans.

Simply put, the record is devoid of any direct evidence bearing on the public's awareness of Diogenes, the Greek philosopher. In order to accept applicant's argument that the marks have completely different meanings, we would need this type of evidence. Sad as it may seem, we have real doubts as to the awareness in this country, even among

highly educated individuals, of Diogenes and his significance in Greek philosophy. Cf.: In re General Electric Co., 304 F.2d 688, 134 USPQ 190 (CCPA 1962); and National Distillers Corp., supra. In sum, we agree with opposer that there is no evidentiary basis upon which to conclude that purchasers are aware of Diogenes and are capable of drawing source-distinguishing significance from their awareness.

Opposer argues that its mark DIGENE is "well known" in the biotechnology industry. So as to be clear on this point, we find that, to the extent that opposer would have us conclude that its mark is famous, the evidence falls short. Although opposer has enjoyed some success with its DIGENE brand products, and the products have been actively promoted, we cannot conclude on the present record that the mark DIGENE has achieved the status of a "famous" mark. Cf.: Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

With respect to actual confusion, opposer claims "[i]t is noteworthy...that, on one occasion, a customer of Digene sent a facsimile cover sheet listing 'Diogene Diagnostics' as the intended recipient of the fax." (brief, p. 28) This is hardly probative evidence of actual confusion. While we can only speculate, the mistake may be easily explained by a

mere typographical error.⁶ In any event, the relevant test here is likelihood of confusion, not actual confusion. As often stated, it is unnecessary to show actual confusion in establishing likelihood of confusion. See, e.g., *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-3 (Fed. Cir. 1990).

For the reasons set forth above, the Board finds that purchasers familiar with opposer's chemicals sold under its trade name and trademark DIGENE would be likely to believe, upon encountering applicant's mark DIOGENES for chemicals, that the respective goods originated with or were somehow associated with or sponsored by the same entity. To the extent that any of applicant's contentions raise a doubt on the issue of likelihood of confusion, such doubt must be resolved in favor of the prior user. In *re Martin's Famous Pastry Shoppe Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

⁶Applicant points out that the mistake is an easy-to-make typographical error on standard QWERTY keyboards because the letters "i" and "o" are next to each other.

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Decision: The opposition is sustained and registration to applicant is refused.

T. J. Quinn

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges
Trademark Trial and Appeal Board